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EXAMINER	
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2167	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/624,918	TOONG ET AL.	
	Examiner	Art Unit	
	Luke S. Wassum	2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 January 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 February 2007* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8 January 2009 has been entered.

Response to Amendment

2. The Applicants' amendment, filed 8 January 2009, has been received, entered into the record, and considered.

3. As a result of the amendment, claims 1, 11, 24, 31, 35 and 39 have been amended. Claims 1-40 remain pending in the application.

Priority

4. The Applicants' claim to domestic priority under 35 U.S.C. § 119(e) to provisional U.S. Patent Application 60/397,542, filed 22 July 2002, is acknowledged.

5. The examiner notes, however, that the provisional application is substantially more limited in its teaching than the instant application. At the least, the provisional application fails to disclose any aspect of analysis involving non-patent publications, association of times with data elements, and also fails to disclose any graphical display of the analysis results.

As a result, *at least* claims 4-10, 12, 13 and 15-17 are not entitled to the priority date of the provisional application, since the limitations claimed are not supported by the disclosure of the cited provisional application.

6. The Applicants' claim to domestic priority under 35 U.S.C. § 120, as a continuation-in-part to U.S. Patent Application 09/645,626, filed 24 August 2000, now U.S. Patent 6,604,114, which is a continuation of U.S. Patent Application 09/454,457, filed 3 December 1999, now abandoned, which claims priority to provisional U.S. Patent Application 60/111,111, filed 4 December 1998, and to provisional U.S. Patent Application 60/111,112, filed 4 December 1998, is acknowledged.

7. The examiner notes, however, that the parent application, 09/645,626, does not appear to fully support the independent claims of the instant invention. At the least,

the limitation that any number of recursive searches may be performed in order to include one or more generations of interrelated data elements does not appear to be disclosed by the parent application, and as such, the instant claims are not entitled to the priority date of the parent or any antecedent applications.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-23 and 29-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

10. In order to conform to the requirements of 35 U.S.C. § 101, a process must either be tied to another statutory class of invention, such as a particular machine or apparatus, or transform underlying subject matter, such as an article or materials, to a different state or thing.

In order to be tied to another statutory class of invention, the claims must include a step which requires the use of a particular machine or apparatus such that the step cannot be performed mentally or manually in a manner that reasonably accomplishes

the intended purpose of the recited invention, as claimed, without the use of a structure. See *In re Bilski*, 545 F3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008).

In the case of independent claims 1 and 11, none of these claims recites a particular machine or apparatus for carrying out any of the claimed steps. All of the claimed steps for searching a database of data elements could be carried out mentally or manually.

Since the claimed invention is not tied to another statutory class of invention, and because the claimed process clearly fails to transform underlying subject matter to a different state or thing, the claims are rendered non-statutory.

11. Dependent claims 2-10, 12-23 and 29-36, fully incorporating the deficiencies of their respective independent claims, are likewise rejected.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 1-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Applicants' specification fails to provide support for the new limitation of performing any number of recursive searches in which any successive search in comparison with the immediately preceding search is capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated data elements without any human intervention.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-9, 11-16 and 18-40 are rejected under 35 U.S.C. 102(b) as being anticipated by **Rivette et al.** (U.S. Patent 6,339,767).

16. Regarding claim 1, **Rivette et al.** teaches a method of searching a database of data elements as claimed, the method comprising:

a) based on a starting data element, identifying a first set of one or more data elements in the database, the data elements of the first set being referenced by the starting data element (see disclosure of the PatentRef table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents which were cited during prosecution of the selected patent [backwards citation report], col. 87, lines 4-10, as well as identifying for a source patent those patents in which the source patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figures 86 and 87);

b) based on the first set, identifying a second set of one or more data elements in the database, the data elements of the second ser referencing one or more of the data elements of the first set (see disclosure of the PatentRef table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents which were cited during prosecution of the selected patent [backwards citation report], col. 87, lines 4-10, as well as identifying for a source patent those patents in which the source patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figures 86 and 87);

c) generating data based on the data elements of the first and second sets and the relationships therebetween (see disclosure of the PatentRef table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents which were cited during

prosecution of the selected patent [backwards citation report], col. 87, lines 4-10, as well as identifying for a source patent those patents in which the source patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figures 86 and 87); and

d) the second set being identified by any number of recursive searches, in which any successive search in comparison with the immediately preceding search is capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated data elements without any human intervention (see disclosure that the patent citation report can be performed and displayed in a recursive fashion with an operator specified depth, col. 88, line 65 through col. 89, line 21).

17. Regarding claim 11, **Rivette et al.** teaches a method of searching a database to identify prior art publications for a starting patent publication as claimed, the method comprising:

a) based on the starting patent publication, identifying a first set of one or more publications in the database, the publications of the first set being cited by the starting patent publication (see disclosure of the PatentRef table storing

information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents which were cited during prosecution of the selected patent [backwards citation report], col. 87, lines 4-10; see also drawing Figure 86);

b) based on the first set, identifying a second set of one or more publications in the database, the publications of the second set citing one or more of the publications of the first set (see disclosure of the PatentRef table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents in which the source patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figure 87);

c) generating data based on the publications of the first and second sets and the citation relationships therebetween (see disclosure of the PatentRef table

storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents which were cited during prosecution of the selected patent [backwards citation report], col. 87, lines 4-10, as well as identifying for a source patent those patents in which the source patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figures 86 and 87); and

d) the second set being identified by any number of recursive searches, in which any successive search in comparison with the immediately preceding search is capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated data elements without any human intervention (see disclosure that the patent citation report can be performed and displayed in a recursive fashion with an operator specified depth, col. 88, line 65 through col. 89, line 21).

18. Regarding claim 24, **Rivette et al.** teaches a processor program for searching a database to identify prior art publications for a starting patent publication as claimed, the processor program being stored on a processor readable medium and comprising instructions to cause the processor to:

a) based on the starting patent publication, identify a first set of one or more publications in the database, the publications of the first set being cited by the starting publication (see disclosure of the PatentRef table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents which were cited during prosecution of the selected patent [backwards citation report], col. 87, lines 4-10; see also drawing Figure 86);

b) based on the first set, identify a second set of one or more publications in the database, the publications of the second set citing one or more of the publications of the first set (see disclosure of the PatentRef table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing

Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents in which the source patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figure 87);

c) generate data based on the publications of the first and second sets and the relationship therebetween (see disclosure of the PatentRef table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents which were cited during prosecution of the selected patent [backwards citation report], col. 87, lines 4-10, as well as identifying for a source patent those patents in which the source patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figures 86 and 87); and

d) wherein said instructions are further capable of causing the processor to identify the second set by any number of recursive searches, in which any successive search in comparison with the immediately preceding search is

capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated data elements without any human intervention (see disclosure that the patent citation report can be performed and displayed in a recursive fashion with an operator specified depth, col. 88, line 65 through col. 89, line 21).

19. Regarding claim 2, **Rivette et al.** additionally teaches a method wherein identifying a first set of one or more data elements includes determining whether the starting data element includes one or more references to one or more other data elements and identifying a first set of one or more data elements based on the references (see disclosure of the PatentRef table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents which were cited during prosecution of the selected patent [backwards citation report], col. 87, lines 4-10; see also drawing Figure 86).

20. Regarding claim 3, **Rivette et al.** additionally teaches a method wherein identifying a second set of one or more data elements includes determining whether one or more data elements in the database include one or more references to one or more of the data elements of the first set and identifying a second set of one or more data elements based on the references (see disclosure of the PatentRef table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents in which the source patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figure 87).

21. Regarding claim 4, **Rivette et al.** additionally teaches a method wherein the starting data element is associated with a starting time and wherein identifying a first set of one or more data elements includes identifying data elements referenced by the starting data element and associated with first times earlier than the starting time (see disclosure of the PatentRef table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module,

col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents which were cited during prosecution of the selected patent [backwards citation report], col. 87, lines 4-10; see also drawing Figure 86; see also disclosure that filing date is included in the Patent Bibliographic Database, col. 18, lines 55-66; see also disclosure of extensive search and retrieval functionality and its relation to patent groups, col. 26 line 38 through col. 31, line 63).

22. Regarding claim 5, **Rivette et al.** additionally teaches a method wherein identifying the second set of one or more data elements includes identifying data elements that reference the data elements of the first set and that are associated with second times later than the first times (see disclosure of the PatentRef table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents in which the source patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figure 87; see also disclosure that filing date is included in the Patent Bibliographic Database, col. 18, lines 55-66; see also disclosure of extensive search and

retrieval functionality and its relation to patent groups, col. 26 line 38 through col. 31, line 63).

23. Regarding claim 6, **Rivette et al.** additionally teaches a method wherein identifying the second set of one or more data elements includes identifying data elements that reference the data elements of the first set and that are associated with second times later than the first times and earlier than the starting time (see disclosure of the PatentRef table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents in which the source patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figure 87; see also disclosure that filing date is included in the Patent Bibliographic Database, col. 18, lines 55-66; see also disclosure of extensive search and retrieval functionality and its relation to patent groups, col. 26 line 38 through col. 31, line 63).

24. Regarding claims 7 and 14, **Rivette et al.** additionally teaches a method further comprising providing the generated data to one or more of a user and a display (see drawing Figures 157-164).

25. Regarding claims 8 and 15, **Rivette et al.** additionally teaches a method further comprising graphically displaying data elements of the first and second sets and the relationships therebetween (see drawing Figure 164).

26. Regarding claims 9 and 16, **Rivette et al.** additionally teaches a method wherein the publications are represented by geometric shapes and wherein the relationships are represented by lines between geometric shapes (see drawing Figure 164).

27. Regarding claims 12 and 13, **Rivette et al.** additionally teaches a method wherein the publications include one or more of patent publications and non-patent publications and wherein the patent publications include one or more of issued patents, published patent applications and non-published patent applications (see disclosure of the PatentRef table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40).

28. Regarding claim 18, **Rivette et al.** additionally teaches a method further comprising based on the second set, identifying one or more candidate patent publications for one or more of invalidating prior art for the starting patent publication, licensing opportunities and seminal prior art (see disclosure of the PatentRef table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents in which the source patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figure 87; see also disclosure that filing date is included in the Patent Bibliographic Database, col. 18, lines 55-66; see also disclosure of extensive search and retrieval functionality and its relation to patent groups, col. 26 line 38 through col. 31, line 63; see also disclosure of the use of patent citation analysis in competitive analysis and strategic planning, col. 103, line 24 through col. 108, line 14).

29. Regarding claims 19 and 25, **Rivette et al.** additionally teaches a method and processor program wherein identifying one or more candidate patent publications for invalidating prior art includes identifying one or more patent publications in the second

set that do not cite the starting patent publication that are not cited by the starting patent publication and that are associated with filing dates earlier than the starting patent publication (see disclosure of the PatentRef table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents in which the source patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figure 87; see also disclosure that filing date is included in the Patent Bibliographic Database, col. 18, lines 55-66; see also disclosure of extensive search and retrieval functionality and its relation to patent groups, col. 26 line 38 through col. 31, line 63; see also disclosure of the use of patent citation analysis in competitive analysis and strategic planning, col. 103, line 24 through col. 108, line 14).

30. Regarding claims 20 and 26, **Rivette et al.** additionally teaches a method and processor program wherein identifying one or more candidate patent publications for licensing opportunities includes identifying one or more patent publications that are associated with a first assignee and that are cited by one or more patent publications associated with one or more different second assignees (see disclosure of the PatentRef

table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents in which the source patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figure 87; see also disclosure that filing date is included in the Patent Bibliographic Database, col. 18, lines 55-66; see also disclosure of extensive search and retrieval functionality and its relation to patent groups, col. 26 line 38 through col. 31, line 63; see also disclosure of the use of patent citation analysis in competitive analysis and strategic planning, col. 103, line 24 through col. 108, line 14, and specifically the disclosure of identification of potential licensees at col. 103, lines 37-58).

31. Regarding claims 21 and 27, **Rivette et al.** additionally teaches a method and processor program wherein identifying one or more candidate patent publications for seminal prior art includes identifying one or more patent publications that cite a first number of patent publications that cite a first number of patent publications and that are cited by a second number of patent publications, wherein the second number is greater than the first number (see disclosure of the PatentRef table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through

col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents in which the source patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figure 87; see also disclosure that filing date is included in the Patent Bibliographic Database, col. 18, lines 55-66; see also disclosure of extensive search and retrieval functionality and its relation to patent groups, col. 26 line 38 through col. 31, line 63; see also disclosure of the use of patent citation analysis in competitive analysis and strategic planning, col. 103, line 24 through col. 108, line 14).

32. Regarding claims 22 and 28, **Rivette et al.** additionally teaches a method and processor program further comprising based on the second set, identifying one or more co-citing patent publications, the co-citing patent publications including patent publications of the second set that are associated with one or more of filing dates later than the filing date of the starting patent publication and publication dates later than the filing date of the starting patent publication (see disclosure of the PatentRef table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53,

which operates to identify, for a particular patent [called a source patent], the patents in which the source patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figure 87; see also disclosure that filing date is included in the Patent Bibliographic Database, col. 18, lines 55-66; see also disclosure of extensive search and retrieval functionality and its relation to patent groups, col. 26 line 38 through col. 31, line 63; see also disclosure of the use of patent citation analysis in competitive analysis and strategic planning, col. 103, line 24 through col. 108, line 14).

33. Regarding claim 23, **Rivette et al.** additionally teaches a method further comprising based on the co-citing patent publications, determining a patent prosecution strategy including one or more of filing one or more claims in a pending application, filing one or more continuing applications of a parent application, declaring one or more interferences and disclosing one or more of the co-citing patent publications to a patent-granting office (see disclosure of the PatentRef table storing information on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent [called a source patent], the patents in which the source patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figure

87; see also disclosure that filing date is included in the Patent Bibliographic Database, col. 18, lines 55-66; see also disclosure of extensive search and retrieval functionality and its relation to patent groups, col. 26 line 38 through col. 31, line 63; see also disclosure of the use of patent citation analysis in competitive analysis and strategic planning, col. 103, line 24 through col. 108, line 14).

34. Regarding claims 29-40, **Rivette et al.** additionally teaches a method and processor program wherein said recursive searching, without user intervention, comprises using one or more queries generated by an application, generated primarily by an application, generated by an computing platform application and generated by a computer application (see Figure 86, disclosing that in step 8610, patents cited by each of the patents by reference to the PatentRef table are identified, the claimed application being anticipated by the disclosed patent citation module).

Claim Rejections - 35 USC § 103

35. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

> the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

36. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

37. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

38. Claims 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rivette et al.** (U.S. Patent 6,339,767) as applied to claims 1-9, 11-16 and 18-40 above, and further in view of **Coleman et al.** ("Aesthetics-Based Graph Layout for Human Consumption").

39. Regarding claims 10 and 17, **Rivette et al.** teaches a method of searching a database of data elements to identify prior art publications for a starting patent publication substantially as claimed.

Rivette et al. does not explicitly teach a method further comprising determining locations at which to display the geometric shapes and lines to reduce overlaps between geometric shapes and crossings between lines.

Coleman et al., however, teaches a method further comprising determining locations at which to display the geometric shapes and lines to reduce overlaps between geometric shapes and crossings between lines (see disclosure of a number of common-sense rules for drawing aesthetically pleasing graphs, section 2.1 Layout Aesthetics, beginning on page 1417).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate rules for drawing aesthetically pleasing graphs, since this would result in a graph that maximized the measure of desirability, or aesthetic, in the resulting graph layout (see Summary, page 1415, et seq.).

Response to Arguments

40. Applicant's arguments filed 8 January 2009 have been fully considered but they are not persuasive.

41. Regarding the Applicants' argument that the prior art of record fails to teach performing any number of recursive searches in which any successive search in comparison with the immediately preceding search is capable of being contracted, expanded or otherwise modified to include one or more generations of interrelated elements without any human intervention, the examiner respectfully disagrees.

The examiner initially points out that there does not appear to be sufficient support for this limitation in the Applicants' specification.

Furthermore, the examiner points out that in the Applicant's invention, there is presumably *some* input provided by a human in order to specify the desired depth, or number of recursions. This type of input on the part of the human is consistent with that disclosed in the **Rivette et al.** reference. For instance, at col. 88, lines 65-67, it is disclosed that the patent citation report can be performed and displayed in a recursive fashion with an operator specified depth. Furthermore, at col. 89, lines 18-20, it is disclosed that the level of the report desired by the operator could be contained in the information that the patent citation module receives in the initial step where the source patents are specified by the user. This means that once the source patents and desired depth are specified, the process proceeds without human intervention.

There is no disclosure in the Applicants' specification that supports the position that the claimed invention operates in a different manner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119, or sent via email at luke.wassum@uspto.gov, **with a previous written authorization in accordance with the provisions of MPEP § 502.03.** Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Luke S. Wassum/
Primary Examiner
Art Unit 2167

lsw
5 March 2009